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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,185	08/23/2001	Charles W. Propst Jr	TPP 30482 A	9479

7590 02/23/2007  
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Washington, DC 20036

EXAMINER
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BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/914,185	PROPST JR, CHARLES W.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher P. Bruenjes	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Response to Amendment***

1. In view of the appeal brief filed on November 13, 2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

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**WITHDRAWN REJECTIONS**

2. The 35 U.S.C. 102 rejection of claim 5 as anticipated by Wang et al of record in the Office Action mailed May 12, 2006, Pages 2-4 Paragraph 3, has been withdrawn due to applicant's appeal brief filed November 13, 2006.

3. The 35 U.S.C. 103 rejection of claim 7 over Wang et al in view of Lu et al of record in the Office Action mailed May 12, 2006, Pages 5-6 Paragraph 6, has been withdrawn due to applicant's appeal brief filed November 13, 2006.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Jugle (USPN 4,971,882).

Jugle anticipate a toner of a conductive polymeric composition. Jugle teaches that the toner is applied to a substrate (col.18, 1.59-68) and that substrates that toner is applied to include paper (col.3, 1.21-30). The coated layer forms a film on the paper layer. Regardless of whether the toner forms a discontinuous or continuous film it still meets the limitation film of a conductive polymeric composition. The limitation that the "polymeric composition is a dried layer formed from an intermediate composition comprising an aqueous composition" is given little patentable weight because it is a method limitation in an article claim. A layer that is not in an aqueous solution has the same properties as a layer formed from an aqueous solution that has been dried, because when dry the layer no longer possesses the water from the aqueous solution. Jugle anticipate a polymeric composition comprising methyl methacrylate (col.7, 1.48 - col.8, 1.10), a quaternary ammonium compound in an amount of 0.1 to 20wt% and preferably 0.1 to 5wt% of the polymeric composition (col.9, 1.27-40), and a polyethylene wax (col.6, 1.44-48). Products of identical chemical composition cannot have mutually exclusive properties. Therefore, if the prior art teaches the identical chemical

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structure, the properties applicant claims are necessarily present. MPEP 2112.01. Because the film is formed of the same composition as the claimed film it inherently imparts a static dissipative property and a conductive property to the paper layer. The limitation that the polymeric composition is applied in an aqueous form and dried is given little patentable weight because articles are defined by structure and not how they were made. Method limitations are only given weight insofar as the structure they provide. MPEP 2113. A composition applied in an aqueous form and dried only provides the structural limitation that the film is a dry layer, which the film of Jugle would be after the toner, is applied to the paper.

6. Claims 5 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanikawa et al (USPN 6,653,036).

Tanikawa et al anticipate a magnetic toner applied directly on and in contact with a paper layer (col.20, 1.10-15). When applied to the paper the toner forms a film on the paper layer. The magnetic toner is formed of a polymeric composition comprising a binder resin formed of methyl methacrylate polymer (col.10, 1.28-63) and a charging controlling agent (col.16, 1.28-29). The charging controlling agent includes quaternary ammonium salts (col.16, 1.30-35 and 45-47) in an amount within

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the claimed 1 to 10wt% based on the weight of the polymeric composition (col.19, 1.10-16). The magnetic toner further comprises a polyethylene wax (col.14, 1.37-39) and zinc oxide particles (col.16, 1.10-24). Products of identical chemical composition cannot have mutually exclusive properties.

Therefore, if the prior art teaches the identical chemical structure, the properties applicant claims are necessarily present. MPEP 2112.01. Because the film is formed of the same composition as the claimed film it inherently imparts a static dissipative property and a conductive property to the paper layer. The limitation that the polymeric composition is applied in an aqueous form and dried is given little patentable weight because articles are defined by structure and not how they were made. Method limitations are only given weight insofar as the structure they provide. MPEP 2113. A composition applied in an aqueous form and dried only provides the structural limitation that the film is a dry layer, which the film of ~~Jugle~~ <sup>Tanikawa et al.</sup> would be after the toner, is applied to the paper. He 2-17-07

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomita et al (USPN 5,783,517).

Tomita et al teach a paper layer coated in direct contact with a dye receiving layer or film (col.1, 1.6-12). The film is a conductive polymeric composition comprising a base polymer comprising methyl methacrylate (col.3, 1.38-48 and col.3; 1.62 - col.4, 1.10). The conductive polymeric composition further comprises a white pigment such as zinc oxide (col.4, 1.50-63), a parting agent such as polyethylene wax (col.5, 1.1-5), and an antistatic agent such as a quaternary ammonium compound (col.5, 1.32-38). Products of identical chemical composition cannot



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have mutually exclusive properties. Therefore, if the prior art teaches the identical chemical structure, the properties applicant claims are necessarily present. MPEP 2112.01.

Because the film is formed of the same composition as the claimed film it clearly imparts a static dissipative property and a conductive property to the paper layer. The limitation that the polymeric composition is applied in an aqueous form and dried is given little patentable weight because articles are defined by structure and not how they were made. Method limitations are only given weight insofar as the structure they provide. MPEP 2113. A composition applied in an aqueous form and dried only provides the structural limitation that the film is a dry layer, which the film of Jugle would be after the toner, is applied to the paper. Whether the film was an aqueous solution during the formation of the dried film is given little patentable weight, because articles are defined by structure and not the method of making the article. There is no substantial structural difference between a dried aqueous layer and a layer that was not previously in aqueous form.

Tomita et al fail to explicitly teach that the quaternary ammonium compound is present in the polymeric composition in an amount of 1 to 10wt% based on the weight of the polymeric composition. However, Tomita et al teach that the sum of the

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added additives should be within the range of 0.5 to 30wt% (col.5, 1.45-51). Therefore, it would have been obvious to one having ordinary skill in the art that the amount of antistatic agent in the composition would be selected depending on the intended end result of the coated paper layer from within the preferred range for all of the additives combined of 0.5 to 30wt%, as taught by Tomita et al, absent the showing of unexpected results. MPEP 2144.05.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 5 and 7 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the

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organization where this application or proceeding is assigned is 571-273-8300.

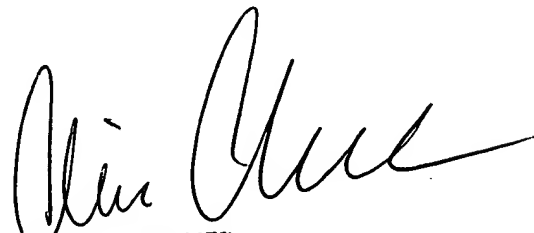
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Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB  
February 15, 2007



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